

07/26/2003 TTAB

Docket No. 2625-174/09705225

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



In re Application of: Levlad, Inc..

Serial No.: 76/185,349

Filed: December 22, 2000

Mark: ORGANIC SPA COLLECTION

Examiner: Steven W. Jackson

Law Office: 114

07-14-2003

U.S. Patent & TMO/TM Mail Rcpt Dt 03

07 JUL 24 P.11 9:31
RECEIVED AND
FILED

BOX TTAB -

NO FEE

Commissioner for Trademarks

2900 Crystal Drive

Arlington, Virginia 22202-3513

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Jean Bove'

Date:

July 11, 2003

BRIEF FOR APPLICANT-APPELLANT

INTRODUCTION

Pursuant to a Notice of Appeal filed with the Trademark Trial and Appeal Board on September 3, 2002, Applicant files it brief on appeal from the Examining Attorney's final refusal to register the above-identified mark made in the Office Action dated March 6, 2002 and, after remand, in the Office action of November 5, 2002 (further time for response having been granted in the advisory paper dated June 10, 2003), and respectfully request the Trademark Trial and Appeal Board to reverse the Examining Attorney's decision on the grounds that the Applicant's mark is not merely descriptive.

STATEMENT OF FACTS

Applicant seeks registration on the Principal Register of its mark, ORGANIC SPA COLLECTION, for the following goods:

Hair shampoo; hair conditioners; hair rinses; suntan lotion; after-bath splash-on; face wash; facial masks; hand and body lotion; moisturizing lotion; skin cream; toothpaste; personal deodorants; non-medicated scalp treatment cream; non-medicated ointment for the treatment of burns; rashes and minor skin disorders, in International Class 003 and

Medicated preparations for scalp care and the treatment of dandruff; dandruff shampoo; medicated ointment for the treatment of burns; rashes and minor skin disorders, in International Class 005.

In the Office Action of June 28, 2001, the Examining Attorney contended that ORGANIC SPA COLLECTION merely describes an ingredient, quality, characteristic, function, feature, purpose, or use of the relevant goods, namely, a collection of organic spa products (e.g., lotion, shampoo, conditioner, skin cream). The Examining Attorney provided separate dictionary definitions for the words “organic”, “spa”, and “collection” as well as LEXIS/NEXIS printout of a search apparently of the words “organic spa” or “spa collection”.

In response to the Office Action of June 28, 2001, the Applicant argued that since the mark ORGANIC SPA COLLECTION requires imagination, thought, and perception to reach a conclusion as to the nature of the goods, it is, therefore, only suggestive of Applicant’s goods.

In the final Office Action of March 6, 2002, the Examining Attorney continued to refuse registration, contending that the words ““organic” and “spa collection” are highly descriptive for a spa collection featuring organic goods” and that the combination of these words creates no incongruity, and no imagination is required to understand the nature of the goods. The Examining Attorney further contended third party registrations showing the descriptive nature of the word “collection.”

On September 9, 2002, applicant filed a response to the Office Action of March 6, 2002 in which it disclaimed the word “organic”, and filed a Notice of Appeal. The Board remanded the case to allow the Examining Attorney to consider applicant’s response. In an Office Action dated November 5, 2002, the Examining Attorney accepted the disclaimer but maintained that the mark, in its entirety, is merely descriptive under Section 2(e)(1). Applicant filed a superfluous Notice of Appeal and on June 10, 2003, the Board issued an order resuming the appeal.

ARGUMENTS***The Examining Attorney has not met the burden of proof of showing mere descriptiveness***

It is well established that marks must be compared in their entireties. Lever Bros. v. Barcolene Co., 463 F.2d 1107 (C.C.P.A. 1972); TMEP 1207.01. A mark should not be split up into its component parts for comparison of each component. Thus, the analysis here must be based upon a definition of Applicant's entire mark "ORGANIC SPA COLLECTION". The Examining Attorney has not found a single citation to evidence that the combination of the words "Organic Spa Collection" is descriptive. The glaring lack of a citation demonstrates that the mark is not descriptive.

Therefore, when there is sufficient doubt concerning the amount and character of the evidence presented in support of the Examining Attorney's position, any doubt must be resolved in Applicant's favor.

The mark is suggestive or of applicant's goods

The Examining Attorney has not established that the mark is merely descriptive, rather than suggestive. A mark is merely descriptive only if it "immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See In Re Abcor Development Corp., 588 F.2d 811, 200 U.S.P.Q. 215, 217-18 (C.C.P.A. 1978) and Plyboo America Inc., v. Smith & Fong Co., 51 U.S.P.Q. 2d 1633, 1640 (T.T.A.B. 1999). However, the determination of descriptiveness must be made in relation to the goods for which registration is sought, the context in which the mark is intended to be used and the possible significance which the mark would have, because of that context, to the average purchaser of the goods. In re Omaha National Corp., 819 F.2d 1117 (Fed. Cir. 1987). Moreover, if the mark, when used in conjunction with the goods, requires any amount of imagination, thought, or perception to reach a conclusion as to the nature of those goods, it is only suggestive. See, In re Abcor Development Corp., supra at 218, and Plyboo America Inc., v. Smith & Fong Co., supra at 1640. It is respectfully submitted that the mark

“ORGANIC SPA COLLECTION” requires thought and imagination to reach a conclusion as to the nature of the goods with which the mark will be used.

The mark ORGANIC SPA COLLECTION is intended for use on hair shampoo; hair conditioners; hair rinses; suntan lotion; after-bath splash-on; face wash; facial masks; hand and body lotion; moisturizing lotion; skin cream; toothpaste; personal deodorants; non-medicated scalp treatment cream; non-medicated ointment for the treatment of burns; rashes and minor skin disorders. The dictionary definitions of “organic” and “spa” provided by the Examining Attorney does not mention or even suggest the above-mentioned goods.

Instead, Applicant’s mark requires prospective customers to go through a multistage reasoning process to capture the connection between its goods and its’ mark ORGANIC SPA COLLECTION. Although the consumer might determine from the mark that the goods involve products relating to or derived from living organisms, or products used at a resort, the consumer would be unable to determine anything else about the goods offered by Applicant, without additional information, investigation, or further thought. For instance, nothing in the mark implies shampoos, soaps, or lotions.

With respect to the degree of imagination, the more imagination that is required on the customer’s part to get some direct description of the product from the term the more likely the term is suggestive, not descriptive. Neither the terms “organic spa collection” combined, nor the terms “organic”, “spa”, and “collection” immediately describe goods for hair care products, lotions, and non-medicated creams. See dictionary definitions of the word “organic.” The American Heritage Dictionary of the English Language, Third Edition includes seven different entries for the word “organic,” several of which include multiple definitions of the term. The terms include “of, relating to, or affecting organs or an organ of the body,” and “of or designating carbon compounds.” The same dictionary includes six different entries for the word “spa,” several of which include multiple definitions of the term. The terms include “A resort providing therapeutic baths” “A health spa” and “A tub for relaxation or invigoration, usually including a device for raising whirlpools in the water.”

Applicant's mark for ORGANIC SPA COLLECTION can be compared in similar manner with the following marks held to be only suggestive, such as:

ACOUSTIC RESEARCH loudspeakers, Bose Corp. v. International Jensen, Inc., 963 F.2d 1517, 22 U.S.P.Q. 2d 1704 (Fed. Cir. 1992);

ACTION SLACKS pants, Levi Strauss & Co., v. R. Josephs Sportswear, 28 U.S.P.Q. 2d 1464 (T.T.A.B. 1993);

ARTYPE cut-out letters for artists, Arttype, Inc. v. Zappula, 228 F.2d 695, 108 U.S.P.Q. 51 (2d Cir. 1956);

AT A GLANCE calendar, Cullman Venture, Inc., v. Columbian Art Works, Inc., 717 F. Supp. 13 USPA2d 1257 (S.D.N.Y. 1989);

AUDIO FIDELITY phonograph records, Audio Fidelity, Inc., London Records, Inc., 332 F.2d 577, 141 U.S.P.Q. 792 (C.C.P.A. 1964);

CHICKEN OF THE SEA tuna fish, Van Camp Sea Food Co. v. Alexander B. Stewart Organizations, 50 F.2d 976 (C.C.P.A. 1931);

CITIBANK urban bank, Citibank, N.A. v. Citibanc Group, Inc., 724 F.2d 1540, 222 U.S.P.Q. 292 (11th Cir. 1984);

CLASSIC COLA soft drink, In re Classic Beverage, Inc., 6 U.S.P.Q. 2d 1383 (T.T.A.B. 1988);

HANDI WIPES dusting cloths, In re Colgate-Palmolive Co., 149 U.S.P.Q. 793 (T.T.A.B. 1966);

MARRIAGE PROPONENTS for prospective marriage partner services, In re Hunt, 132 U.S.P.Q. 564 (T.T.A.B. 1962);

THE REAL YELLOW PAGES phone directory, U.S. West, Inc. v. BellSouth Corp., 18 U.S.P.Q. 2d 1307 (T.T.A.B. 1990).

It is respectfully submitted that since a good deal of imagination is required to associate the mark with the products it is very unlikely that the word will be needed by competitors to describe their products. Registration of ORGANIC SPA COLLECTION would not prohibit other from using the term "Organic" or "Spa" separately, in a descriptive manner and in appropriate circumstances. Therefore, the registration of ORGANIC SPA COLLECTION would not violate public policy considerations that prohibit the registration of merely descriptive marks.

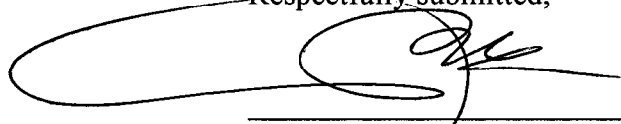
Additionally, the term "ORGANIC" is registrable when used in conjunction with another term as evidenced by the numerous registrations on the Principal Register containing "ORGANIC" and another term, e.g., SIMPLY ORGANIC (Reg. No. 2583547 for skin care preparations); ORGANIC ROOT STIMULATOR (Reg. No. 2124517 for hair care preparations); ORGANIC EXCELLENCE (Reg. No. 2494976 for hair and body care products). Exhibit B appended to Applicant's Response filed September 3, 2002 showed over 25 registrations containing "Organic" with another term in International Classes of 003 and 005.

Finally, if there is any doubt as to whether the term is merely descriptive, such doubt should be resolved in favor of the Applicant. In re Pennwalt Corp., 173 U.S.P.Q. 317, 319 (T.T.A.B. 1972) (DRI-FOOT for foot anti-perspirant found not merely descriptive); In re Bel Paese Sales Co., 1 U.S.P.Q. 2d 1233, 1235 (T.T.A.B. 1986) (DOLCELATTE for cheese found not merely descriptive) and In re Bed-Check Corporation, 226 U.S.P.Q. 946 (T.T.A.B. 1985).

Conclusion

The mark ORGANIC SPA COLLECTION is suggestive, not merely descriptive of its goods, since the mark, when used in conjunction with the goods, requires an amount of imagination, thought, or perception to reach a conclusion as to the nature of those goods. The mark should not be refused registration on the Principal Register.

Respectfully submitted,



Robert Berliner
Registration 20,121
Attorney for Applicant

July 11, 2003
Fulbright & Jaworski L.L.P.
865 S. Figueroa Street, 29th Floor
Los Angeles, CA 90017-2576

Phone: 213-892-9237

1103

FULBRIGHT & JAWORSKI L.L.P.

A REGISTERED LIMITED LIABILITY PARTNERSHIP
865 SOUTH FIGUEROA STREET, 29TH FLOOR
LOS ANGELES, CALIFORNIA 90017
WWW.FULBRIGHT.COM

RBERLINER@FULBRIGHT.COM
DIRECT DIAL: (213) 892-9237

TELEPHONE: (213) 892-9200
FACSIMILE: (213) 680-4518

July 11, 2003



07-14-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

BOX TTAB / NO FEE
Commissioner for Trademarks
2900 Crystal Drive, South Tower
Arlington, VA 22202-3513

Re: Mark: ORGANIC SPA COLLECTION
Serial No.: 76/185,349
Applicant: Levlad, Inc.
Class: 003, 005
Our Ref. 2625-174/09705225

Dear Sir:

Enclosed, please find two copies of the "Brief for Applicant" to the Trademark Trial and Appeal Board, appealing the Trademark Attorney's final refusal to register the above-referenced trademark application.

Please indicate your receipt of said document by stamping and returning the enclosed postage-paid postcard via regular mail.

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-0337, a duplicate of this letter is attached.

Very truly yours,

Robert Berliner

RB:jb
Enclosures

07/30/2003 TTAB
011898706729

FULBRIGHT & JAWORSKI L.L.P.

A REGISTERED LIMITED LIABILITY PARTNERSHIP
865 SOUTH FIGUEROA STREET, 29TH FLOOR
LOS ANGELES, CALIFORNIA 90017
WWW.FULBRIGHT.COM

RBERLINER@FULBRIGHT.COM
DIRECT DIAL: (213) 892-9237

TELEPHONE: (213) 892-9200
FACSIMILE: (213) 680-4518

July 11, 2003



07-14-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

BOX TTAB / NO FEE
Commissioner for Trademarks
2900 Crystal Drive, South Tower
Arlington, VA 22202-3513

Re: Mark: ORGANIC SPA COLLECTION
Serial No.: 76/185,349
Applicant: Levlad, Inc.
Class: 003, 005
Our Ref. 2625-174/09705225

Dear Sir:

Enclosed, please find two copies of the "Brief for Applicant" to the Trademark Trial and Appeal Board, appealing the Trademark Attorney's final refusal to register the above-referenced trademark application.

Please indicate your receipt of said document by stamping and returning the enclosed postage-paid postcard via regular mail.

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-0337, a duplicate of this letter is attached.

Very truly yours,

Robert Berliner

RB:jb
Enclosures